PATENT CASE: IN01481KC

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of: | |
| **A. Palani *et al.*** | Examiner: Celia C. Chang |
| Serial No.: **10/628,933** | Group Art Unit: 1625 |
| Filed: **July 29, 2003** | Date: August 17, 2005 |
| For: **"PIPERIDINE DERIVATIVES USEFUL AS CCR5 ANTAGONISTS** | |



Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE**

Sir:

This communication is in response to the Office Action issued on June 17, 2005 in the subject case. This communication is being faxed to the Examiner's attention at 703-872-9306. A petition for one month extension of time is enclosed herewith.

Claims 21-40 are originally pending in the case. The Examiner restricted the claims into seven groups:

Group I: Claims 24 drawn to compounds of formula (I), wherein both $R^1$ and $R^2$ are nonheterocyclic, and $R^3$ is substituted or unsubstituted pyrimidine. Claims 21-23, 25-30 drawn to compounds and pharmaceutical compositions are also included within this Group with the elected compounds to the extent that both $R^1$ and $R^2$ are nonheterocyclic;

Group II: Claim 23 drawn to compound of formula (I), wherein $R^1$ is piperidine, and $R^3$ is substituted or unsubstituted pyrimidine. Claims 21-22, and 25-30 drawn to compounds and pharmaceutical compositions are also included within this Group with the elected compounds to the extent that $R^1$ is piperidine;

Group III: Claims 21, 25-30 drawn to compounds of formula (I) and pharmaceutical compositions comprising said compounds, wherein $R^3$ is substituted or unsubstituted heteroaryl not encompassed by Groups I or II;

Group IV: Claims 31-33 drawn to methods of treating human immunodeficiency virus;

Group V: Claims 34-36, drawn to methods of treating human immunodeficiency virus employing compounds of claim 1 or 4 and additional one or more antiviral or other agents;

Group VI: Claims 38-39, drawn to a method of treating solid organ transplant rejection, graft v. host disease, rheumatoid arthritis, inflammatory bowel disease or multiple sclerosis, using single or multiple active ingredients; and

Group VII: Claim 40, drawn to a pharmaceutical "kit", i.e., medicinal packaging.

The Examiner additionally required: a) if electing from among Groups I-III, the election of a single disclosed species for prosecution on the merits; b) if electing from group IV, the election of a single disclosed active compound for the method; c) if electing from group V, the election of a single disclosed "combination" of one active compound with every active ingredient in the combination named, for the method; and d) if electing from group VI, the election of a single disclosed disorder together with a single active ingredient alone or a single disclosed "combination" of one active compound with every active ingredient in the combination named, for the method.

Applicants are puzzled by the restriction into these numerous Groups. Applicants believe that all claims 21-40 form part of one and the same invention. Applicants further believe that when there is a linking claim encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 21-40 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submit that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if " there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above seven groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

Furthermore, in order to comply with the Examiner's requirement, Applicant is electing, with traverse, the invention cited as Invention Group No. I by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant is electing compound #56, the first compound on page 61 of the specification.

On page 5 of the Office Action, the Examiner has indicated that the compounds of Group I have been elected prosecuted in the parent application, and that the Applicant, in order for the reply to the present restrict requirement to be complete, must include an election of the remaining invention to be examined even though the requirement be traversed.

In response, Applicant is separately filing a declaration of express abandonment per 37 C.F.R. §1.138 for the parent case to preclude any overlap between the present case and the parent. A copy of this declaration is enclosed herewith.

If the Examiner has questions, the Examiner is invited to contact the undersigned.

August 17, 2005

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Respectfully submitted,

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